

REMARKS

Applicants have amended claims 1-3, 5-7, 9-17. Claims 1-18 are now pending in this application.

In the Office Action dated August 6, 2004, the Examiner has made the following rejections:

- Claims 1-10, 11-13 and 15-17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention;
- Claims 1-10 and 14 under 35 U.S.C. 101 stating that the claimed invention is directed to non-statutory subject matter;
- Claims 1-18 under 35 U.S.C. 102(e) as being anticipated by Beverina et al. (U.S. publication no. 2001/0027388); and
- Claims 17 and 18 under 35 U.S.C. 102(3) as being anticipated by or in the alternative under 35 U.S.C. 103(a) as obvious over Beverina.

The undersigned has reviewed the August 6, 2004, Office Action and respectfully traverses all rejections for the reasons set forth herein. No new matter has been added. The undersigned respectfully requests that all pending claims, as amended, be allowed.

a. 35 U.S.C. 112, second paragraph

The Examiner has rejected Claims 1-10, 11-13 and 15-17 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

With respect to claims 1, 15, 16 and 17, the Examiner purported that the phrase "selection of an element" was indefinite. The Applicant has amended claims 1, 15, 16 and 17 so that they succinctly claim the selection of the "first or second element" which should make it clear to the Examiner which element is claimed.

With respect to claim 3, the Examiner purported that the limitation “the element” lacked sufficient antecedent basis. The amended claim 3 now succinctly claims the “first or second element selected” which provides specific antecedent basis for the element claimed.

With respect to claim 11, the Examiner purported that it was unclear how a computer screen can be related to a facility and how a computer screen can comprise an image. The Applicant has amended claim 11 so that claim 11 currently claims a graphical user interface that is associated with a particular facility and comprises one or more graphical images of the particular facility. The Applicant respectfully suggests that the amendments make the relationship between the elements clear.

Accordingly, the Applicant respectfully suggests that all of the Examiner’s concerns related to 35 U.S.C. 112 have been addressed and requests that the Examiner withdraw the rejections under 35 U.S.C. 112.

b. 35 U.S.C. 101

The Examiner has rejected Claims 1-10 and 14 under 35 U.S.C. 101 stating that the claimed invention is directed to non-statutory subject matter. Applicants respectfully traverse this rejection.

In the concurring opinion of *State Street, and AT&T Corp. v. Excel Communications Inc.*, 172 F.3d 1352, 1355, 50 USPQ2d 1447 (Fed. Cir. 1999) (hereinafter AT&T), Judge Dixon quotes *State Street* and AT&T to illustrate that a particular invention (the Bowman invention) was directed to non-statutory subject matter because the process was not tied to an apparatus, such as a computer, either expressly or by implication. Applicant respectfully points out that Applicant’s claimed invention is clearly tied to a computer apparatus.

In the specification, a host system 150 and e-commerce participant computers 101-106 are described which will execute the method steps (p. 6 lines 1-33). A person skilled in the arts will understand the described system to be computer apparatus, which ties the invention to the “technological arts.”

Claims 1-10 and 14 are clearly stated to be “computer implemented” methods, and therefore require the use of one or more computer devices (as described on pages 9-11 of the specification) which provides a nexus to a technological art. The Federal Circuit has indicated that such inventions are statutory subject matter (AT&T 50 USPQ2d at 1449).

Accordingly, the Applicant respectfully traverses the 35 U.S.C. §101 rejection based upon a need for additional nexus to a technological art, and retains the right to pursue other claims which may or may not include similar claim language in one or more continuation and/or divisional applications.

However, in an effort to further the prosecution and expedite allowance of the immediately pending claims the Applicant has amended independent claims 1 and 14 so that they specifically include reference to the technological art of computer apparatus. Specifically, claims 1 and 14 now include reference to computer storage devices and computer processors, thereby definitively linking them to a technological art. Applicant respectfully requests that the Examiner withdraw the rejection under 35 U.S.C. 101.

c. 35 U.S.C. 102(e)

The Examiner has rejected Claims 1-18 under 35 U.S.C. 102(e) as being anticipated by Beverina et al. (U.S. publication no. 2001/0027388). Applicants respectfully traverse this rejection for the reasons below, and request allowance of the claims.

Beverina describes methods and systems for managing risk based upon simulation and a gaming environment (paragraph 10). Beverina uses a persistent object database to store information about actors, physical surroundings and historical events, and decision making techniques to infer the relative risk of an undesirable event. According to Beverina, a user must build a model of a site in interest so that the simulation can construct and analyze possible routes a terrorist may take to reach a location. Beverina then selects a most probable route and calculates the likelihood of success or accessibility (paragraph 11).

Beverina requires a user to input information into a graphical user interface (GUI) and import files from a computer aided design (CAD) program to build a representation of buildings, roads, and perimeters of a site and to identify population centers. A virtual assessment of the representation is acted upon by various modules to assess risk associated with a physical attack on the site modeled. However, the modules only act in the abstract to simulate the threat of ingress according to user provided realistic physical properties (i.e. paragraph 312). Beverina is a glorified video game, similar to a flight simulator or other program that combines realistic features with a made up simulation.

As the Federal Circuit instructs “anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration.” W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983). Furthermore, the prior art reference must disclose each element of the claimed invention “arranged as in the claim.” Lindermann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452 (Fed. Cir. 1984). Thus, in order for the present rejection under 35 U.S.C. 102(b) to be proper, the Boesch reference “must clearly and unequivocally disclose the claimed [invention] without any need for picking, choosing, and combining various disclosures not directly related to each other by the teachings of the cited reference.” In re Arkley, 455 F.2d 586, 588 (C.C.P.A. 1972).

With regards to the independent claims, 1, 11, 14,15 and 17 the present invention provides methods and apparatus useful to identify actual, real risks based upon real data gathered from real time sources. As amended, the claims require that the indication of a security risk include at least one of: a potential for physical, reputational, economic or legal harm to the resource and is received from government agency or a news feed. In addition, the indication must be received on a real time basis distinguishing over the hypothetical simulation data of Beverina.

In another aspect, digital data is also received from the government agency or news feed that is descriptive of the security, an element not anticipated or suggested by Beverina.

In considering the dependent claims, claims 2-10 depend from independent claim 1, claims 12-13 depend from claim 11, and claim 18 depends from claim 17, each define further features and structure of the methods claimed in the independent claim. As such, claims 2-10 and claims 12-13 are patentable for the reasons noted above with respect to claims 1 and 29, as well as for the additional features recited therein.

Limitations which Beverina specifically does not provide for include, a political or national boundary to be an element selected. Beverina also does not provide for the use of real images of actual facilities or resources to aid in the assessment of actual imminent risk. Nor does Beverina provide for a security risk that comprises misappropriation of data stored in a computerized information system. Additionally, Beverina does not provide for transmission of a subjective quantifier that is descriptive of the amount of harm that may be caused by the security risk. Still additionally Beverina does not provide for a hierarchical relationship that progresses from a country level to a room level in a facility.

Since Beverina does not describe or suggest the receipt of any real world data, it cannot and does not anticipate receipt of an image of an element and transmitting the image with a description of the security risk as it relates to the element. Beverina also does not provide for color coding risks according to the degree of risk, the type of risk, the type of element, the value of the assets or the propensity of the risk to grow.

For the reasons set forth, the Applicant respectfully submits that the claims are in condition for allowance and the Applicant requests timely notice to such effect.

d. 35 U.S.C. 103(a)

The Examiner has rejected Claims 17 and 18 under 35 U.S.C. 102(3) as being anticipated by or in the alternative under 35 U.S.C. 103(a) as obvious over Beverina (US Application 2001/0027388 A1). Applicants respectfully traverse this rejection for the reasons below, and requests allowance of the claims.

To establish a case of obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the references' teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant's disclosure. MPEP 706.02(j), citing In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Further a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Thus, in order for the Examiner to establish a case of obviousness, he must (a) demonstrate that the prior art references describe or suggest all of the claimed limitations of the present invention, and (b) show a motivation to modify or combine the references. As discussed above with respect to the 102(e) rejection, Beverina has done neither.

Beverina simply does not describe or suggest computer data signal embodied in a digital data stream, nor does Beverina describe or suggest the specific limitations in claims 17-18 which the computer data signal embodies as it is operative with a computer for causing the computer to perform specific steps. Accordingly, for the reasons discussed in regards to the 102(e) rejection above, and because Beverina does not describe or suggest a computer data signal, the Applicant respectfully submits that claims 17-18 are in condition for allowance and request notification of such.

Application No. 10/737,217
Amendment dated November 17, 2004
Reply to the Office Action of August 6, 2004

CONCLUSION

For the reasons set forth above, allowance of this application is courteously urged.

Please charge any fees due in connection with this Amendment to Deposit Account No.

50-0521.

Respectfully submitted,

Date: November 17, 2004

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